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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,616	03/06/2001	Laurent Gauche	PF980061	3464
24498	7590	02/08/2006	EXAMINER	
THOMSON LICENSING INC. PATENT OPERATIONS PO BOX 5312 PRINCETON, NJ 08543-5312			PICH, PONNOREAY	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/786,616	Applicant(s) GAUCHE, LAURENT	
	Examiner Ponnoreay Pich	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-9 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>01312006</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-9 are pending.

Response to Arguments

Applicant's arguments have been considered, but are moot in view of new rejections presented below. Applicant's arguments are directed at amended claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 1 as amended recites "means for selecting an entitlement management message intended for a given detachable security element". It is unclear what makes a detachable security element a "given" detachable security element. The examiner assumes any detachable security element is a given detachable security element since any detachable security element can be given. Given security element is also recited in the last limitation of claim 1.
2. Claim 1 as amended recites "means for storing said entitlement management message when said given security element is not inserted in the decoder and transmitting said stored entitlement management message to said given security element upon insertion of said given security element in said decoder". It is unclear if the storing and transmitting are performed by the same object means

or by separate object means. As currently recited, the means for storing and means for transmitting can be interpreted as being performed by one object or separate objects. The examiner will consider both interpretations to the limitation in applying art rejection.

3. Any claims not specifically addressed are rejected by virtue of dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muratani et al (US 6,061,451) in view of Sakamoto et al (US 6,373,904).

Claim 1:

Muratani discloses:

1. At least one device intended to read and/or to write data from/to a detachable security element supplied by a service provider (Fig 6, item 111).
2. Filters intended to select at least one message for managing entitlements which a user possesses with regard to a service supplied by said provider from among a data stream received (Fig 6, item 113; col 2, lines 4-12; and col 9, lines 16-22).
3. Means for selecting an entitlement management message intended for a given detachable security element (Fig 6, items 113 and 115).

Muratani does not explicitly disclose means for storing said entitlement management message when said given security element is not inserted in the decoder and transmitting said stored entitlement management message to said given security element upon insertion of said given security element in said decoder. However, the limitation is implicitly disclosed by Sakamoto (col 7, line 64-col 8, line 3).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to modify Muratani's invention according to the limitations recited in claim 1 in light of Sakamoto's teachings. One of ordinary skill would have been motivated to do so because Sakamoto discloses his teachings would allow permit the watching and listening operations to rapidly start when changing over from a digital receiving system's standby mode (col 2, lines 60-67), i.e. when the decoder is off.

Claim 5:

Muratani further implicitly discloses the detachable security element is a smart card (col 9, lines 50-56).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muratani et al (US 6,061,451) in view of Sakamoto et al (US 6,373,904) and further in view of Chaney (US 6,035,037).

Claim 6:

Muratani does not explicitly disclose the identification parameter contained in the security element is the address of the smart card. However, Chaney discloses the limitation (col 10, lines 51-59).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to further modify Muratani's invention according to the limitations recited in claim 6. One of ordinary skill would have been motivated to do so because Chaney discloses that by including address information in EMM, a service provider can direct EMM to a particular card (col 10, lines 51-59). This would make a cable broadcast system more secure against piracy.

Allowable Subject Matter

Claims 2-4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 2-4 contain allowable subject matter as indicated in the prior office action and an updated search confirms the subject matter is still allowable.

Claims 7-9 are allowed. Claims 7-9 were indicated in the prior office action as containing allowable subject matter and an updated search confirms the subject matter is still allowable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ponnoreay Pich
Examiner
Art Unit 2135

PP


KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100